



UNITED STATES PATENT AND TRADEMARK OFFICE

CK

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,270	05/23/2005	Hidegori Nakajima	260617US0PCT	5020
22850	7590	08/10/2007		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER	
			MITRA, RITA	
		ART UNIT	PAPER NUMBER	
		1656		
		NOTIFICATION DATE	DELIVERY MODE	
		08/10/2007	ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)
	10/511,270	NAKAJIMA ET AL.
Examiner	Art Unit	
Rita Mitra	1656	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 June 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
- a) The period for reply expires 3 months from the mailing date of the final rejection.
- b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) They raise the issue of new matter (see NOTE below);
- (c) They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. Applicant's reply has overcome the following rejection(s): would have overcome 102(b) over Valenzuela.
6. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. For purposes of appeal, the proposed amendment(s): a) will not be entered, or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 46.

Claim(s) objected to: _____.

Claim(s) rejected: 20-28, 30 and 47.

Claim(s) withdrawn from consideration: 29 and 31-45.

AFFIDAVIT OR OTHER EVIDENCE

8. The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. Other: _____.

Continuation of 3

Regarding rejoining of human SEQ ID NO: 3 and rat SEQ ID NO: 1, it would require further consideration and search. The non-elected composition claim 44 will be rejoined upon finding allowability of the product claim 30.

Claim 20 has been amended to recite “consisting of a coding region of a polypeptide that binds to WF00144, which has a molecular weight of about 35 kD and which has at least 96% homology to SEQ ID NO: 1, which is a nucleic acid sequence and not a polypeptide sequence. However amended claim has raised new issue, which would require further consideration and search. Claim 20 has 112, second paragraph issue because it is not clear how a polypeptide sequence has homology with nucleic acid sequence of SEQ ID NO: 1. Also it is not clear in claim 20 the molecular weight is associated with the polypeptide or WF00144.

Claims 20, 21, 22, 23, 24, have raised new issues, which would require further consideration and search. The recitation of the closed language “consisting of” in claim 20 is inconsistent with the “at least 96%” in claim 21, 22, 25, and with “comprising” of claims 23 and 24.

Claim 47 is an improper Markush. There should be two separate claims, one drawn to the viral vector, the other to the liposome.

Continuation of 5

The amendment to claim 30 by removing the limitation “or a fragment thereof consisting of at least 15 consecutive bases” **would have** overcome the rejection of claims 21 and 30 under 35 U.S.C. 102 (b) over Valenzuela.

Continuation of 11

The following art rejection is maintained because of the reasons given below. The rejection of record as follows:

Claims 20-28, 30, 47 remain rejected under 35 U.S.C. 102(a) as being clearly anticipated by Tang et al. and by Strausberg et al.

Tang et al. (US 60/336,453) disclose a polynucleotide sequence (sequence 103) with 96.6% sequence identity to the elected polynucleotide of the invention designated as SEQ ID NO: 1. This clearly anticipates claims 20, 21, 22, 24, 27, 28 under 102 (a). Tang et al. (US 60/336,453) disclose a polynucleotide sequence encoding a protein that comprises an amino acid sequence of SEQ ID NO: 2 with 99.6% sequence identity to the peptide of the invention designated as SEQ ID NO: 2. This clearly anticipates claim 20, 23, 25, 26 under 102(e).

Strausberg et al. (2002) disclose a polynucleotide sequence (accession BC045550) with 96.6% sequence identity to the elected polynucleotide of the invention designated as SEQ ID NO: 1. This clearly anticipates claims 20, 21, 22, 24 under 102 (a). Strausberg et al. (2002) disclose a polynucleotide sequence encoding a protein that comprises an amino acid sequence of

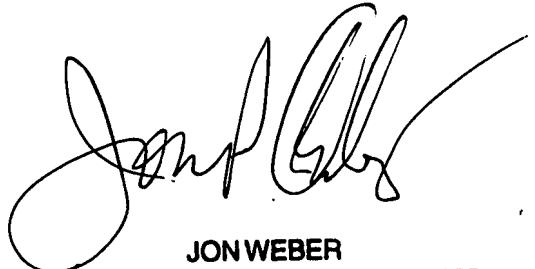
Art Unit: 1657

SEQ ID NO: 2 with 100% sequence identity to the elected peptide of the invention designated as SEQ ID NO: 2. This clearly anticipates claims 20, 23, 25, 26 under 102(e).

Above rejection was posted in the previous office action. In response Applicants traverse the rejection and submit that (page 8) this rejection using Tang reference would not apply to the amended claims, which require that the polynucleotide encodes a polypeptide having molecular weight of 35 kD that binds to WF00144. Applicants' arguments have been noted but not found persuasive because the property of binding is inherent. If a polypeptide with 99.6% sequence identity with SEQ ID NO: 2 can bind WF00144, same polypeptide with 35 kD molecular weight should also bind to said WF00144.

Similar consideration is applied to Strausberg because this reference teaches a polynucleotide that has 96.6% sequence identity to SEQ ID NO: 1, wherein the polynucleotide encoding a protein that comprises an amino acid sequence which has 100% sequence identity to SEQ ID NO: 2.

Thus the rejection of the claims under 35 U.S.C 102 as anticipated by Tang and by Strausberg is maintained.



JON WEBER
SUPERVISORY PATENT EXAMINER

Rita Mitra, Ph.D.

July 24, 2007